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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/423,572	11/29/1999	RALF TIMMERMANN	MO-5366/LEA3	6913
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MARC J. FARRELL REED SMITH LLP 213 MARKET STREET, 9TH FLOOR P.O. BOX 11844 HARRISBURG, PA 17108-1844			EXAMINER COLE, ELIZABETH M	
			ART UNIT 1771	PAPER NUMBER

DATE MAILED: 11/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/423,572

Applicant(s)

TIMMERMAN ET AL.

Examiner

Elizabeth M Cole

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5 and 8-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5 and 8-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not *identically disclosed* or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be *negated* by the manner in which the invention was made.

1. Claims 1,3-5,10, 16-17 rejected under 35 U.S.C. 103(a) as being unpatentable over JP 07-125128 A to So et al in view of WO 96/19599 to Lorcks et al, (equivalent to U.S. 6,218,321). So et al discloses a material comprising a first ply of natural fibers and a second ply of biodegradable fibers such as aliphatic polyesters. So et al discloses that the basis weight of the natural fiber nonwoven layer may be 30-200 grams per meter squared. See page 4, paragraph 0015. So et al discloses that the basis weight of the biodegradable nonwoven layer may be 10-70 grams per meter squared. See page 3, paragraph 0011. The natural fibers may comprise hemp fibers. See page 4, paragraph 0012. The material may be formed into bags. See page 8, last line. The recitation that the material comprises a coffee or tea bag has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). So et al differs from the claimed invention because So et al does not refer to the first and second plies

of the nonwoven fabric as plies of filter material. The recitation of the plies as being part of the filter material is a statement of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Additionally, Lorcks et al teaches at col. 7, line 54 - col. 8, line 45 and col. 8, line 66 - col. 9, line 13, that fabrics comprising both biodegradable polymers and natural fibers can be formed into a variety of materials. Those materials include wipes, protective garments, sacks and agricultural fabrics such as those discussed in So et al at paragraph 0001, page 1, as well as filters and other permeable materials. Therefore, Lorcks et al teaches that the type of fabric disclosed in So et al is also suitable for use for making porous or permeable materials. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have formed the material of So et al into additional structures such as filter materials, because Lorcks et al teaches that the same materials which are useful for forming agricultural fabrics as taught by So et al are also useful for forming into filters. One of ordinary skill in the art would have been motivated to form the So et al fabric into a filter because Lorcks et al teaches that these types of fabrics are also suitable for making filters and other permeable materials. It further would have been obvious to have selected the degree of

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permeability which would produce the desired filtration properties in the filter material through the process of routine experimentation since the filtration properties are known to be related to the pore size, basis weight, etc., in a filter.

2. Claims 8-9, 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over So et al in view of Lorcks et al as applied to claims 1,3-5,10, 16-17, and further in view of Pophusen et al, U.S. Patent No. 5,928,739. So et al discloses a material as set forth above. So et al differs from the claimed invention because So et al teaches that the biodegradable material may comprise an aliphatic polyester, but does not teach the other biodegradable materials set forth in claims 8-9 and 11-15. Pophusen et al teaches that along with aliphatic polyesters, the other biodegradable materials set forth in claims 8-9 and 11-15 are known to be useful in forming nonwoven materials which are biodegradable. See col. 3, lines 23-32. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed the biodegradable materials of claims 8-9 and 11-15 to form the biodegradable nonwoven of So et al because Pophusen et al teaches that such materials are known to be equivalent to the aliphatic polyesters disclosed by So et al for the purpose of forming biodegradable nonwoven fabrics.

3. Claims 8-9, 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over So et al in view of Lorcks et al as applied to claims 1,3-5,10, 16-17, and further in view of Lorcks et al, WO 96/31561, (equivalent to U.S. Patent No. 6,096,809 So et al discloses a material as set forth above. So et al differs from the claimed invention because So et al teaches that the biodegradable material may comprise an aliphatic polyester, but does not teach the other biodegradable materials set forth in claims 8-9 and 11-15. Lorcks WO 96/31561 teaches teaches

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that along with aliphatic polyesters, the other biodegradable materials set forth in claims 8-9 and 11-15 are known to be useful in forming nonwoven materials which are biodegradable. See col. 4, line 61 – col. 5, line 45 and col., 11, lines 52-67. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed the biodegradable materials of claims 8-9 and 11-15 to form the biodegradable nonwoven of So et al because Lorcks WO 96/31561 et al teaches that such materials are known to be equivalent to the aliphatic polyesters disclosed by So et al for the purpose of forming biodegradable nonwoven fabrics.

4. Applicant's arguments filed 8/25/03 have been fully considered but they are not persuasive. With regard to the 112 1st paragraph rejection, Applicant's amendment has overcome this ground of rejection and therefore this rejection is withdrawn.

With regard to the limitations in the preamble, since the claims have been amended to incorporate the recitations of a filter material within the body of the claim, these arguments are moot.

With regard to the combination of So et al in view of Lorcks et al, Applicant argues that Lorcks does not teach or suggest a multi-ply material and does not teach employing biodegradable fibers and natural fibers. However, Lorcks clearly teaches at col. 9, that the biodegradable fibers can be processed into nonwovens, felts and textile composites and that these webs can be strengthened by additional threads, woven or nets, for example, of similar or different material such as cellulose fibers or other vegetable fibers such as cotton, kapok, sisal, flax, hemp, jute, ramie, wool or silk. Lorcks further teaches that the webs, felts and textile composites can be used for

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producing filters. See col. 9, lines 1-13. Thus, Lorcks does teach combining natural and biodegradable synthetic fibers in a single fabric, and further teaches that this fabric may have multiple plies. Further, Lorcks teaches that these fabrics may be formed into filters. Therefore, a *prima facie* case of obviousness has been established.

Applicant further argues that neither Lorcks nor So teaches connecting the plies by interpenetration of said thermoplastic fibers and said natural fibers. However, So teaches that the fabric is made of a nonwoven fabric layer made of biodegradable thermoplastic synthetic long fibers and a nonwoven fabric layer made of natural fibers mechanically interlaced together.

With regard to the combination of So in view of Lorcks and further in view of Pophusen, Applicant argues that Pophusen et al is not prior art because priority has been perfected in the instant application. It is noted that a certified translation of the priority document has not been received, and therefore, the Pophusen reference has not been withdrawn. However, a new rejection with regard to these claims is also set forth above employing a new reference which has a publication date of 10/10/96.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth M. Cole whose telephone number is (703) 308-0037. The examiner may be reached between 6:30 AM and 6:00 PM Monday through Wednesday, and 6:30 AM and 2 PM on Thursday.

Mr. Terrel Morris, the examiner's supervisor, may be reached at (703) 308-2414.

Inquiries of a general nature may be directed to the Group Receptionist whose telephone number is (703) 308-0661.

The fax number for all official faxes is (703) 872-9306. The fax number for unofficial faxes is (703) 305-5436.

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A handwritten signature in cursive script, appearing to read "Elizabeth M. Cole".

Elizabeth M. Cole
Primary Examiner
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e.m.c